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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,151	12/27/2001	Lorenzo Mendizabal	Hartford-9	1595
28581	7590	09/15/2005	EXAMINER	
DUANE MORRIS LLP PO BOX 5203 PRINCETON, NJ 08543-5203			LANEAU, RONALD	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,151

Applicant(s)

MENDIZABAL ET AL.

Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The amendment filed on 7/7/05 has been entered. New claims 19-21 are added and claims 1 and 3-21 are now pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 3-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodwin et al (US 2003/0220867 A1) in view of Wilkinson et al (US 2002/0099637 A1).

As per claims 1, 6-9, 12-14 and 17-21, Goodwin discloses a computer method of auctioning at least one claim or asset in bankruptcy over a communication network, said method comprising the steps of: identifying potential buyers for said at least one claim or asset using at least one of a plurality of factors, the factors comprising previous purchasing behavior, industry links, and market research (page 7, [0101]); notifying selected ones of the potential buyers of the availability of said at least one claim or asset (page 10, box [0118]); registering ones of said buyers who have expressed an interest in bidding on said at least one claim or asset (page 11, box [0131]); obtaining bids from said registered buyers over the network (page 1, boxes [0003], [0004]); and accepting a highest one of said bids if said highest one of said bids satisfies a predetermined criteria and notifying said registered buyer from which said highest one of said bids was obtained of the acceptance thereof; or rejecting said bids if said bids do not satisfy said

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predetermined criteria (page 9, box [0110]). Goodwin does not explicitly disclose determining a market value but Wilkinson discloses determining a market value of said at least one claim or asset using historical data of same or similar claims or assets (page 4, [0107]); dynamically adjusting said market value based on known factors (pages 1-2, [0011]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the fair market value as taught by Wilkinson into the system of Goodwin because it would provide sophisticated, underlying analytical valuation system that can generate the consistent, dependable values needed for reliable financial markets.

As per claims 3-5, 10 and 11, Goodwin discloses a method wherein the step of determining a market value comprises: accessing historical data of sales of claims or assets previously recorded (page 5, box [0083]); determining an asset unit value based on said historical data; and formulating said market value based on said asset unit value and number of assets available (page 4, [0107]). Neither Goodwin nor Wilkinson discloses an asset unit value that is determined as a weighted average and wherein said weights are determined in accordance with factors selected from the group comprising: number of assets, duration of sale, or date of sale but it is rather quite obvious that that Goodwin's system is capable of determining the asset value base on factors such as number of assets, duration of sale, or date of sale as claimed.

As per claims 15-16, Goodwin discloses a system comprising at least one input/output device interposed between said communication network and said processor to provide information items from said network to said processor and from processor to said network (see fig. 1), a system that comprises an Internet (see abstract).

Response to Arguments

4. Applicant's arguments filed on 7/7/05 have been fully considered but they are not persuasive.

Applicant argues that Goodwin in view of Wilkinson do not disclose, teach or suggest "identifying potential buyers for said at least one claim or asset using at least one of a plurality of factors, the factors comprising previous purchasing behavior, industry links, and market research." Contrary to Applicant's arguments, this is how potential buyers are identified over the Internet. One would have to monitor the buyer's behavior by at least identifying the different sites or items of interest for said buyer and make a decision as to the possibility said buyer is interested in an auction and notify said buyer of the item being up for auction. Applicant's argument are deemed unpersuasive, claims 1 and 3-21 are finally rejected.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RL

Ronald Laneau
Examiner
Art Unit 3627

Handwritten signature: R. Laneau
R. Laneau
Examiner

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